

Appl. No. 09/801,564
Amdt. dated November 8, 2005
Reply to Office Action of August 11, 2005

PATENT

REMARKS/ARGUMENTS

Amendments

Before this Amendment, claims 1, 2, 4-13, and 15-24 were present for examination. Claims 1, 9, and 18 are amended. Claim 15 is canceled, and no claims are added. Therefore, claims 1, 2, 4-13, and 16-24 are present for examination, and claims 1, 9, and 18 are the independent claims. No new matter is added by these amendments. Applicants respectfully request reconsideration of this application as amended.

35 U.S.C. §103 Rejections

Claims 1-2, 4-5, 7, and 18-20 were rejected under 35 U.S.C. §103(a) as being obvious over the cited portions of Lin et al., U.S. Pat. No. 5,959,874 ("Lin"), in view of the cited portions of Nakakimura et al., U.S. Pat. No. 5,915,109 ("Nakakimura"). Claims 6, 9-10, 12-13, 16, and 21-22 were rejected under 35 U.S.C. §103(a) as being obvious over Lin in view of Nakakimura and the cited portions of Pineda, U.S. Pat. No. 5,701,263 ("Pineda"). Claims 8, 17, and 23 were rejected under 35 U.S.C. §103(a) as being obvious over Lin in view of Nakakimura and additional cited references. The Applicants note with appreciation that claim 15 was merely objected to, and was not rejected, and thus Applicants assume that the claim is allowable if rewritten in independent form.

1. Scaling Factor Claims: The Office Action Summary and the Detailed Action indicate that dependent claim 15 is objected to, but not rejected. The Applicants interpret this to indicate that the claim is allowable if rewritten in independent form. Claim 9, the independent claim from which claim 15 depends, is rewritten to include the limitations from claim 15. The Applicants, therefore, respectfully submit that independent claim 9 is now allowable. Claims 10-13, 16, 17, and 24 each depend from claim 9, and these claims are believed allowable for at least the same reasons.

2. Single Instruction - Missing Teachings: As noted above, independent claims 1 and 18 were rejected under 35 U.S.C. §103(a) as being obvious over Lin in view of Nakakimura. Claims 1 and 18 have now been amended to recite the claimed embodiments more particularly.

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To establish *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP §2143. Applicants believe significant limitations from independent claims 1 and 18 are neither taught nor suggested in the references. More specifically, neither Lin nor Nakakimura can be relied upon to teach or suggest a *single instruction* comprising an **arithmetic function** to be performed using an **immediate value** and a **plurality of operands**, the immediate value and source addresses for the operands **specified in the single instruction**. The Applicants respectfully request that the anticipation rejection be withdrawn for these reasons.

Neither Lin or Nakakimura describe a single instruction including an operation to be performed, an immediate value, and addresses of a plurality of operands, wherein the operation is to be performed using the immediate value and each operand of the plurality. The instruction-level parallelism of the present embodiments describe a single instruction to perform operations that would take at least two instructions applying the teachings of Lin and Nakakimura.

3. Single Instruction - Motivation to Combine: Moreover, to establish a *prima facie* showing of obviousness, the "teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art, not in the applicant's disclosure." MPEP § 2143.

But in rejecting the independent claims at issue (claims 1 and 18), the Office has instead relied upon the assertion that "it would have been obvious to a person having ordinary skill in the art [to combine the references because] it leads to improve the overall system performance" (Office Action dated August 11, 2005 ("Office Action"), p. 3, ll. 13-18). The Office based its motivation to combine argument upon the contention that the references, when combined, offer benefits. This is not the proper standard.

Unless the art itself "suggests the desirability of the combination," benefits alone are not enough. MPEP 2143.1. The implicit *benefits* of a combination are insufficient to establish the necessary motivation. Since no cite was made to the art itself for a *suggestion or motivation to combine*, the Applicants assume that Official Notice is being relied upon, and request an express showing of documentary proof under MPEP §2144.03 if this line of reasoning is maintained.

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It is well established that "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The Applicants respectfully assert that independent claims 1 and 18 are now allowable for at least the foregoing reasons. Claims 2, 4-8, and 19-23 each depend from claims 1 and 18, and these claims are believed allowable for at least the same reasons.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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